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Paper No. 48
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United States Olympic Committee
v.
MEOB, Inc., and America's Team Properties, Inc. (joined
as party defendant)

Cancellation No. 92025167

James L. Bikoff of Silverberg, Goldman & Bikoff, L.L.P.
for United States Olympic Committee.

David W. Beehler of Robins, Kaplan, Miller & Ciresi,
L.L.P. for MEOB, Inc., and America's Team Properties,
Inc. (joined as party defendant).

Before Seeherman, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Respondent America's Team Properties, Inc. is the
owner (by assignment from respondent MEOB, Inc.) of
Registration No. 1,899,914, of the mark AMERICA'S TEAM
(in typed form; AMERICA'S disclaimed) for goods
identified as "clothing, namely shirts." The

registration was issued to MEOB, Inc. on June 13, 1995,¹ and was assigned to America's Team Properties, Inc. in April 1998. Hereinafter, we shall refer to these respondents jointly as "respondent," except where otherwise noted.

On June 3, 1996, petitioner filed a petition to cancel the registration (which at that time was still owned by MEOB, Inc.). Petitioner pleaded two grounds for cancellation in the petition to cancel. The first pleaded ground is abandonment, under Trademark Act Sections 14(3) and 45, 15 U.S.C. §§1064(3) and 1127). Specifically, petitioner alleged that "Moeb Incorporated is not currently making use in interstate commerce of the mark AMERICA'S TEAM within the scope of the challenged registration" and that "Moeb Incorporated has abandoned the mark AMERICA'S TEAM by discontinuing use of the mark with no intent to resume use." (Petition to Cancel, ¶5.) The second ground for cancellation asserted in the petition to cancel is "false suggestion of a connection" under Trademark Act Section 2(a), 15 U.S.C. §1052(a). However, petitioner's brief on the case makes no argument with respect to, nor even mention of, this Section 2(a)

¹ Section 8 affidavit filed and accepted. The registration matured from an intent-to-use application filed on June 6, 1990.

ground for cancellation. We therefore deem petitioner to have waived that ground, and we deny the petition to cancel with respect thereto. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.3 (TTAB 2002).²

In its answer, respondent denied the salient allegations of the petition to cancel.

Petitioner and respondent each submitted main briefs, but petitioner did not submit a reply brief. Neither party requested an oral hearing.

The evidence submitted by the parties in this case consists of:

(a) the parties' September 20, 2001 evidentiary stipulation to the effect that respondent's involved registration has been cited as a Section 2(d) bar to two pending applications owned by petitioner for registration of the marks AMERICA'S TEAM and AMERICA'S HOME TEAM;

(b) petitioner's September 28, 2001 notice of reliance on the following: (i) respondent's interrogatory answers; (ii) the transcript of the August 28, 2001 testimony deposition of Brian Reichel, president of respondent America's Team Properties, Inc., and

² We note that, in any event, the evidence of record fails to prove the Section 2(a) ground for cancellation.

exhibits thereto; (iii) the transcript of the August 28, 2001 testimony deposition of Terrence Nash, president of respondent MEOB, Inc., and exhibits thereto; (iv) a copy of respondent's involved registration and a printout (from the Office's records) of

the history thereof; (v) the above-referenced September 20, 2001 evidentiary stipulation regarding petitioner's applications; (vi) copies of certain applications and registrations owned by petitioner; (vii) the "testimonial declaration" of Bert Fainberg, petitioner's former Associate General Counsel; (viii) the declaration (and attached exhibits) of John T. Parker, a paralegal at petitioner's counsel's law firm; and (ix) printouts of NEXIS articles (apparently offered in support of petitioner's now-waived Section 2(a) claim);

(c) respondent's November 8, 2001 notice of reliance on the following: (i) the same exhibits listed above as nos. (i)-(v) to petitioner's notice of reliance; (ii) the November 6, 2001 affidavit (and attached exhibits) of Brian Reichel (president of America's Team Properties, Inc.); and (iii) the November 1, 2001 affidavit (and attached exhibits) of Terrence Nash (president of MEOB, Inc.); and

(d) petitioner's rebuttal notice of reliance on (i) the notarized affidavit (and attached exhibits) of Stacy E. Jenkins (a paralegal at an Albuquerque, New Mexico law firm), a non-notarized copy of which had been submitted with petitioner's first notice of reliance as an exhibit to the declaration of Mr. Parker's declaration; and (ii)

the declaration (and attached exhibits) of Michael Reagan (the director of Trademark Licensing for the University of Washington).

Two comments regarding this evidence are in order. First, the testimony depositions (and attached exhibits) of Mr. Reichel and Mr. Nash should have been filed in accordance with the provisions of Trademark Rule 2.125(c), 37 C.F.R. §2.125(c), rather than as exhibits to a notice of reliance. However, because both parties submitted the depositions as exhibits to their respective notices of reliance, we have deemed the depositions and their exhibits to be of record. Second, the above-referenced declarations or affidavits of Bert Fainberg, John T. Parker and Stacy E. Jenkins (submitted by petitioner) and of Brian Reichel and Terrence Nash (submitted by respondent) were not properly made of record, given the absence of any written stipulation by the parties for submission of such testimony in declaration or affidavit form, as required by Trademark Rule 2.123(b), 37 C.F.R. §2.123(b). However, because neither party has objected to the other's declaration or affidavit evidence on this basis, but instead has treated such evidence as being of record and indeed has submitted much of its own evidence in the same fashion, we deem

each party to have stipulated to the other's submission of such evidence. *See, e.g., Hilson Research Inc. v. Society of Human Resource Management*, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993). However, we have accorded to these declarations and affidavits, and their attached exhibits, only such probative value as each warrants.

Respondent has stipulated that petitioner is the owner of two applications which have been refused registration on account of respondent's involved registration. In view thereof, we find that petitioner has standing to bring this cancellation proceeding. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Having found that petitioner has waived its pleaded Section 2(a) ground for cancellation, we turn now to the remaining pleaded ground, i.e. abandonment. A registered trademark may be canceled if it has been abandoned. *See Trademark Act Section 14(3), 15 U.S.C. §1064(3)*. A mark is considered abandoned

[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Trademark Act Section 45, 15 U.S.C. §1127. Abandonment must be proved by a preponderance of the evidence, and the burden of persuasion remains on the party seeking cancellation even if a statutory prima facie case of abandonment has been established. *See On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

If the registration at issue originated from an intent-to-use application, then the three-year period of nonuse, proof of which would constitute a prima facie case of abandonment, is deemed to have commenced with the filing of the statement of use in the application which matured into the registration. Any period of nonuse of the mark which occurred prior to the filing of the statement of use is irrelevant to the abandonment determination. *See Consolidated Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153 (TTAB 2002). In this case, the statement of use was filed on January 31, 1995.³

³ In view thereof, the parties' arguments and evidence on the issue of whether respondent MEOB, Inc. made valid use of the mark in 1990 (in connection with its license agreement with the

We will assume, *arguendo*, that respondent's activities with respect to the mark in the three years subsequent to the filing of the statement of use and up to the present time (such as its efforts to license the mark and its donations of shirts bearing the mark to charity) do not constitute "use in commerce" under the Lanham Act,⁴ and that petitioner therefore has established a statutory prima facie case of abandonment. However, we find that such prima facie case has been rebutted, because any nonuse of the mark by respondent which occurred after the institution of this cancellation proceeding is excusable nonuse.⁵

In the petition to cancel, petitioner alleged, *inter alia*, that it is the owner of the mark AMERICA'S TEAM (Petition to Cancel, ¶7). In an August 5, 1998 letter from petitioner's counsel to respondent, petitioner maintained its claims of prior and superior rights in the

University of Washington, or in connection with the 1990 Goodwill Games) are irrelevant to the abandonment issue herein.

⁴ We need not and do not address the parties' respective arguments on this question.

⁵ When petitioner filed the petition to cancel on June 3, 1996, less than three years had passed since respondent's filing of the statement of use. Therefore, petitioner cannot establish (and indeed did not plead) a prima facie case of abandonment based on three consecutive years' nonuse prior to the filing of the petition to cancel.

mark, and demanded that respondent withdraw its registration and cease any use or intended use of the registered mark. (See Reichel Testimony Depo., Exh. 20, Respondent's Deposition Exhibit 00001.) In view of these allegations and assertions by petitioner that it has superior rights in the mark vis-à-vis respondent and that respondent is not entitled to its registration, and the resulting cloud of uncertainty as to whether respondent's rights in the registration would survive the proceeding, we find that respondent was justified in limiting or postponing its use of the mark pending the outcome of the cancellation proceeding. See, e.g., *Penthouse International, Ltd. v. Dyn Electronics, Inc.*, 196 USPQ 251 (TTAB 1977) ("Moreover, nonuse of a mark pending the outcome of litigation to determine the right to such use or pending the outcome of a party's protest to such use constitutes excusable nonuse sufficient to overcome any inference of abandonment").

Additionally, and again assuming *arguendo* that petitioner has established a prima facie case of abandonment and thus is entitled to an inference that respondent does not intend to resume use of the mark, such inference is rebutted by the fact that respondent has actively defended its right to its registration by

litigating this proceeding throughout the more than seven years in which the proceeding has been pending. See *Penthouse International, Ltd. v. Dyn Electronics, Inc.* *supra*. Likewise, even if we were to assume that respondent's activities with respect to the mark undertaken after the institution of this proceeding do not constitute technical use of the mark in commerce (a question we need not and do not reach), these activities certainly preclude any finding that respondent has abandoned all claims to the mark or that respondent has no intent to resume use of the mark in the event that the proceeding is concluded in its favor.

In summary, because any nonuse of the mark by respondent is excused by the pendency of this litigation, and because we cannot conclude that respondent has no intent to resume use of the mark, we find that petitioner has failed to prove the abandonment ground pleaded in the petition to cancel.⁶

⁶ In its brief, petitioner argues for the first time that not only has respondent abandoned the mark, but respondent has never made bona fide use of the mark in commerce. To the extent that this argument is intended to support a ground for cancellation (i.e., that the registration is void because respondent failed to make bona fide use of the mark in commerce prior to the filing of the statement of use) which is different from or in addition to the ground pleaded in the petition to cancel (i.e., that respondent has abandoned the registered mark because it is not "currently" using the mark and has "discontinued use with no intent to resume use"), we have not considered it. Such

Decision: The petition to cancel is denied.

"nonuse" was not pleaded as a ground for cancellation in the petition to cancel, nor did petitioner ever move to amend its pleading to add such a ground. See Trademark Rule 2.107, 37 C.F.R. §2.107; Fed. R. Civ. P. 15(a). Moreover, we cannot conclude that this issue (i.e., whether respondent's four interstate sales of shirts in January 1995 constituted "use in commerce" which was legally sufficient to support the filing of the statement of use) was tried by the express or implied consent of the parties, such that the pleadings should be deemed to be amended pursuant to Fed. R. Civ. P. 15(b). It is apparent from the tenor of respondent's arguments in its brief that respondent was not on notice that the validity of its statement of use, per se, was under attack and at issue in this proceeding. See *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978).